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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,792	04/04/2001	Kouzou Kage	P/1139-99	2659
7590	11/08/2005		EXAMINER	
STEVEN I. WEISBURD, ESQ. DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS-41ST FLOOR NEW YORK, NY 10036-2714			WOZNIAK, JAMES S	
			ART UNIT	PAPER NUMBER
			2655	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/825,792	KAGE ET AL.
	Examiner	Art Unit
	James S. Wozniak	2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 9/1/2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 April 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the office action from 6/21/2005, the applicant has submitted an amendment, filed 9/1/2005, amending claims 1 and 5, while arguing to traverse the art rejection based on the limitation regarding a means for adding a translation fee to a phone call rate (*Amendment, Page 6*). Applicant's arguments have been fully considered, however the previous rejection is maintained, altered only with respect to the claim amendments and due to the reasons listed below in the response to arguments.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive for the following reasons:

With respect to **Claim 1**, the applicant argues that the prior art of record fails to teach a means for counting a translation time to determine a translation fee which is added to a phone call rate (*Amendment, Page 6*). The examiner notes that such an accounting means is taught by a combination of the teachings of Brotz (*U.S. Patent: 4,882,681*), Rutten et al (*U.S. Patent: 6,632,251*), and Davitt (*U.S. Patent: 5,392,343*), however, the applicant argues that there is no motivation to combine the teachings of Brotz and Rutten since Rutten is directed towards document translation, while Brotz is directed towards spoken language translation (*Amendment,*

Page 8). In response to such an argument, the examiner points out that, as noted in the previous office action (pages 3-4) Brotz and Rutten are analogous art since they are from a similar field of endeavor in language translation. Furthermore, it is of note that spoken language translation and document translation are directly related in that the actual translation of the language in both processes ultimately involve the translation of text. In the spoken language translation system of Brotz, speech is processed and converted to text for translation (*Col. 3, Line 15- Col. 4, Line 20*), while Rutten teaches the translation of a text document (*Col. 1, Line 62- Col. 2, Line 61*). Thus, since Brotz and Rutten are analogous art in the field of language translation and further in the field of language involving the translation of text, the combination of such references is proper. Additionally, Brotz and Rutten are analogous art because they are from a similar field of endeavor in translation providing services and the motivation for combining the references is provided by Rutten, as noted in the previous office action (*Page 4*).

In response to the applicant's argument that translation time counting means taught by Rutten is not equivalent to that of the presently claimed invention, the examiner notes the translation time counting means taught by Rutten (*Col. 12, Lines 52-62*) effectively determines the amount of time a translation service is needed in performing a translation, which is equivalent to the amount of time required for a translation because upon fully completing a translation, the translation service would no longer be necessary. Also, the fact that a single user is billed for a translation service in Rutten is equivalent to the claimed invention, which requires billing a user that initiated the translation request, and when taken in combination with the teachings of Brotz, which provide for a two-way translation service, teaches the translation time counting means of the presently claimed invention.

With respect to the applicant's argument that Rutten fails to teach an accounting apparatus involving the translation serves of telephone communications for a plurality of telephone users, the examiner notes that such a limitation is taught by Brotz in view of Rutten, as noted above. Furthermore, within the scope of the teachings of Davitt, a first or second user can be billed for based on which user initiated the phone call and the translation service request (*Col. 7, Line 51- Col. 8, Line 2*). The presently claimed invention requires that a first user requests a translation (*claim 1, lines 6-8*) and thus would be billed (*claim 1, lines 16-17*), which is explicitly taught by Davitt (*Col. 7, Line 51- Col. 8, Line 2*).

In response to the applicant's argument that Davitt fails to teach how a translation fee can be determined and billed when a machine translation is involved in telephone communications (*Amendment, Page 9*), the examiner notes that Brotz in view of Rutten provides such a teaching. As noted above, Rutten teaches determining a cost for a machine translation service, while Brotz teaches a translation service for translating a telephone conversation. The teachings of Davitt are relied upon to provide the teaching of adding a translation service fee to a phone bill (*Col. 7, Line 51- Col. 8, Line 2*). Thus, the teachings of Brotz, Rutten, and Davitt provide the aforementioned claim limitation and the references are analogous art because they are from a similar field of endeavor in language translation and translation providing services.

In response to applicant's argument that the references fail to show certain features of applicant's invention (*Amendment, Page 9*), it is noted that the features upon which applicant relies (i.e., determining and billing a fee for *machine translation*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to **Claim 5**, see the response to arguments directed towards claim 1.

The dependent claims further limit rejected independent claims, and thus, also remain rejected.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brotz (U.S. Patent: 4,882,681) in view of Rutten et al (U.S. Patent: 6,632,251), and further in view of Davitt et al (U.S. Patent: 5,392,343).

With respect to **Claim 1**, Brotz discloses:

Delivering language information as to its own language as well as the other person's language, a telephone number of a first telephone terminal as well as a telephone number of a second telephone terminal belonging to said other person (*telephone numbers would be inherently included and required in order to establish the connection between the two cellular telephone devices shown in Fig. 2*) together with information for requesting translation from said

first telephone terminal to a network at the time of establishing a phone line (*selector frequency, Col. 3, Lines 32-54*),

Connecting said first telephone terminal with said second telephone terminal by means of said network through a translating apparatus, which has been previously prepared (*Col. 3, Lines 32-54, and Fig. 2*);

Translating a speaking in said first telephone terminal and a speaking in said second telephone terminal by means of said translating apparatus in accordance with said language information to deliver both the spoken contents translated to their opposite parties' telephone terminals, respectively (*Col. 3, Line 32- Col. 4, Line 58, and language translators, Fig. 2*);

Brotz does not teach a means for counting the translation time in determining a price for a translation service, however Rutten discloses such a means (*timing system, Col. 12, Lines 52-62*).

Brotz and Rutten are analogous art because they are from a similar field of endeavor in language translation. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Brotz with the means for determining a charge for a translation service based on time as taught by Rutten to in order to implement a means of calculating a charge for additional services provided to a user in order to receive payment for those extra services (*Rutten, Col. 12, Lines 55-57*).

Brotz in view of Rutten teach a means for providing a translation of a telephone conversation and billing that translation as noted above, however Brotz in view of Rutten do not teach a means for adding that bill to a phone call rate, however Davitt recites adding fees for a language translation service (interpreter) to a telephone call bill for the caller that initiated the call and translation request (*Col. 5, Line 59- Col. 6, Line 5; Col. 7, Line 51- Col. 8, Line 2*).

Brotz, Rutten, and Davitt are analogous art because they are from a similar field of endeavor in language translation. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Brotz in view of Rutten with the means for adding a fee for translation services to a call charge in order to provide a caller with a detailed billing record that includes call and additional service fees (*Davitt, Col. 5, Line 65- Col. 6, Line 5*).

With respect to **Claim 2**, Brotz additionally discloses:

The first telephone terminal and the second telephone terminal are cellular phones (*cellular telephone, Col. 3, Lines 24-27*).

With respect to **Claim 3**, Davitt additionally discloses:

Network is a fixed telephone network (*POTS, Col. 6, Lines 12-17*).

With respect to **Claim 4**, Brotz in view of Rutten, and further in view of Davitt teaches the speech translation system featuring a billing calculation means, as applied to Claim 1. Although neither Brotz, Rutten, nor Davitt specifically suggest that the telephone network is an internet phone network, the examiner takes official notice that it would have been obvious to utilize a telephone system internet network embodiment to further increase method compatibility with a commonly used and readily available internet telephone network type.

Claims 5-8 contain subject matter similar to Claims 1-4, respectively, and thus, are rejected for the same reasons.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Tsumura (*U.S. Patent: 5,815,196*)- teaches a method for adding a charge for a value-added service to a phone bill.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Wozniak whose telephone number is (571) 272-7632. The examiner can normally be reached on M-Th, 7:30-5:00, F, 7:30-4, Off Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James S. Wozniak
10/12/2005



W. R. YOUNG
PRIMARY EXAMINER